

Question 1, worth 30 points, was drawn to claim drafting. The Question presented three options -- A, B or C. Petitioner chose Option C. Petitioner originally received nineteen points for his answer. The March 28, 1991 decision added four more points, for a total of 23. The May 21, 1991 decision added one more point, for a total of 24. Petitioner requests that two more points be added.

Question 2, worth 30 points, was drawn to drafting an Information Disclosure Statement. Petitioner originally received 24 points for his answer. Neither of the above decisions added any points. Petitioner requests that one point be added.

Question 3, worth 40 points, was drawn to drafting the necessary documents in response to an Office action. Petitioner originally received fifteen points for his answer. The March 28, 1991 decision added one point, for a total of sixteen. The May 21, 1991 decision added no points. Petitioner requests that five points be added.

FACTUAL REVIEW

Question 1, Option C

Question 1, Option C, sets forth a description and flow diagram of a process for the recovery of elemental sulfur, silver and gold from pyrite mineral ore. The process includes a multitude of steps. Two are relevant here. One involves lixivating to produce an aqueous pulp containing sulfur, Au and Ag containing solids and dissolved iron, copper and zinc. The

other involves separating by decanting an aqueous layer from an organic solvent layer.

Question 1, Option C, requires the drafting of a single claim drawn to the process as shown and described. The instructions for the question state, inter alia, that all steps as described and illustrated in the flow diagram are essential to the invention and that the claim must positively recite and interrelate all essential steps in the process and must identify the chemical elements, compositions and compounds at each step in the process as well as other conditions . . . to the extent given in the foregoing description.

One point each was deducted from petitioner's answer, respectively, for

- (1) omitting the contents of the aqueous pulp, and
- (2) omitting decanting.

The Director found that the deduction of one point for each of the above items (1) through (2) was proper.

With regard to item (1), the Director found that the instructions clearly required the identification of the chemical elements, compositions and compounds at each step of the process. He found further that petitioner's reference to paragraph i) in his answer as identifying the elements of the aqueous pulp was incorrect. He found that that paragraph recites the product of mixing the aqueous pulp with an organic solvent to form an upper aqueous phase and a lower organic solvent phase, and that the answer defined the elements of the

new product formed, not the aqueous pulp as it existed prior to mixing with the organic solvent.

With regard to item (2), the Director found that the invention discloses decanting as the procedure used to separate the aqueous layer from the organic solvent layer, that the instructions stated that the described steps were essential to the invention and must be set forth in the claim, and that it was not discretionary to substitute other language.

Petitioner requests addition of one point for each of items (1) through (2), for a total of two points.

Question 2

Question 2 sets forth information, all of which is stated to be material to the examination of a patent application of a client claiming, as the sole claim, a novel sintered ceramic composition which is set forth in the Question. The information includes a description of prior art. The only prior art relevant here is a sales receipt resulting from the sale by the client of an item identified as "CAC Stock 12-345" on the sales receipt. That item is described in an internal memo of the client as a sintered ceramic. The composition of this sintered ceramic is specifically recited in the memo. The composition is different from the composition recited in the claim of the patent application. The Question requires the drafting of an Information Disclosure Statement (IDS) from the information set forth.

Two points were deducted from petitioner's answer for not

identifying, in essence, the composition of the sintered ceramic identified on the sales receipt. Petitioner's answer states, in pertinent part:

. . . sales receipt which states that we had a sintered ceramic for sale . . . which is similar to that in the current application.

The Director found that the deduction of two points was proper. He found that the statement that the ceramic sold was "similar to" the claimed ceramic is extremely vague and does not reveal any information to the examiner on the composition of the ceramic sold.

Petitioner requests the addition of one point.

Question 3

Question 3 sets forth information about a novel hook fastening device for a clothesline. The device provides solutions to the problem of fastening a coat hanger to a clothesline. The device attaches to a clothesline and a coat hanger hook, and has an upper jaw, a lower jaw, and a coil spring that closes the upper and lower jaws. The device was made in France. The inventor has filed a U.S. patent application on October 10, 1989 fully disclosing two embodiments of his invention. In the preferred embodiment, the lower jaw has two spaced-apart branches that straddle the coat hanger hook and press upward against the bottom of the clothesline. At the same time, the single member upper jaw presses the coat hanger hook downward against the clothesline,

resulting in the hook and clothesline being clasped together to prevent the hook from moving along the clothesline or blowing off the clothesline. In the non-preferred embodiment, both lower and upper jaws have two spaced-apart branches that straddle and reach past the coat hanger hook to clasp the clothesline. This embodiment does not clasp the hook itself and is therefore less effective than the preferred embodiment. The non-preferred embodiment was disclosed by the inventor in an article published in the French Clothespin Journal on April 1, 1988. The patent application contains three claims. Independent claim 1 is drawn to a device for fastening a coat hanger hook to a clothesline comprising upper and lower jaws and a closing member for urging the two jaws toward a closed clasping position. Claim 2 depends from claim 1 and is drawn to the preferred embodiment. Claim 3 depends from claim 1 and is drawn to the non-preferred embodiment. The inventor has also filed a patent application in France, on October 11, 1988 and he has filed a claim for foreign priority under 35 U.S.C. 119 in his U.S. application.

The inventor has received an Office action. Claim 1 was rejected under 35 U.S.C. 102(a) as anticipated by a common spring clothespin. Claim 2 was rejected under 35 U.S.C. 103 as obvious over the device disclosed by the inventor in the French Clothespin Journal article. Claims 1 and 3 were rejected under 35 U.S.C. 102(b) as anticipated by the device in the Journal article. The response is due today. The inventor is a citizen

of France. He does not have a birth certificate but his French passport shows that he was born on July 3, 1905.

Question 3 requires the drafting of all necessary documents to properly respond to the Office action and to pursue the inventor's expressed desire to advance and accelerate the prosecution of his patent application.

In his answer to Question 3, petitioner filed an amendment cancelling claim 1. He did not amend claim 2 or claim 3. He refers, with respect to claim 2, to an affidavit of the applicant under 37 CFR 1.132. The affidavit states, inter alia, the applicant's date of birth and that it was not obvious to him that the modifications and changes to the everyday clothespin he made would work; he has found nothing similar; significant commercial interest has been expressed; and that if it were obvious, others would have developed it and sold it. He refers, with respect to claims 2 and 3, to "37 § 155" and a claim for priority with respect to the French application.

Among the 24 points ultimately deducted from the answer to Question 3, seven points were deducted for not arguing the nonobviousness of the modification over the Journal and common clothespins, and the advantages of the modification which are not suggested by the prior art, and for arguing the claim of foreign priority when such a claim does not obviate a rejection under 35 U.S.C. 102(b).

The Director found that the deduction was proper. He

found that only a generalized statement that the invention is not obvious over the prior art was made and that to overcome a 35 U.S.C. 103 rejection, it must be pointed out with specificity how the claimed invention distinguishes over the prior art and why it would not be obvious to make the invention in view of the prior art. The Director found also that petitioner improperly relied upon the foreign priority in an attempt to obviate the 35 U.S.C. 102(b) rejection.

Petitioner requests the addition of one point.

Eleven points were deducted for not including a petition to make special based on the inventor's age.

The Director did not explicitly make a finding on that deduction in the May 21, 1991 decision. In the March 28, 1991 decision, however, he found that while petitioner's answer made reference to a petition to make special, he did not prepare the petition and provide the necessary proof of age. Therefore, the deduction was proper.

Petitioner requests the addition of at least four points, for a total of at least five points on Question 3.

DECISION

Question 1, Option C

I find no error in the deduction of one point for each of items (1) and (2) in the discussion of Question 1, Option C, supra.

With regard to the deduction for not reciting the composition of the pulp, petitioner argues that his answer is

more descriptive than the model answer, that the model answer is ambivalent, and that his answer more specifically identifies the contents of the pulp in later steps, particularly in paragraph i), which is an equally viable alternative.

Petitioner's arguments ignore the instruction, pointed out by the Director, that the composition "must" be identified at "each" step of the process. Petitioner did not follow this instruction with respect to the aqueous pulp. The Director was correct in not adding one point on this ground.

With regard to the deduction for omitting decanting as the means for separating, petitioner argues that his use of the term "separating" is sufficient and that any reference to decanting would be an unnecessary limitation.

Petitioner's arguments ignore the instruction that all steps described and illustrated are essential to the invention. Petitioner is arguing, in effect, that separating is the same as decanting. It is not. There are numerous ways of separating one liquid layer from another in a mixture. Decanting is only one. By arguing that decanting would be an unnecessary limitation, petitioner is, in essence, seeking to change the facts in the Question. The Director was correct in not adding one point on this ground.

Question 2

I find no error in the deduction of two points for failing to recite the composition for the sintered ceramic which was sold in Question 2.

Petitioner argues that his reference to the sintered ceramic which was sold as "similar to" the claimed sintered ceramic merits one-half credit, i.e., one point. That argument is not well-taken.

An IDS, by definition, is intended to bring information material to the examination of a patent application to the Office. Thus, mere reference to the sales receipt in the IDS is, in essence, a statement that the item sold that is evidenced by the sales receipt is material. Adding that the item is "similar to" the claimed invention adds little, if anything, since if the item is material, it is necessarily at least similar, if not the same. In other words, the sale evidenced by the sales receipt would not likely be material if the sintered ceramic sold was not, at least similar to, the claimed sintered ceramic. Petitioner has already received the full amount of credit allotted for referring to the sale in the IDS. Petitioner's description would still necessitate further query by the examiner of what the actual composition of the "similar" product was. The deduction of two points was appropriate.

Question 3

With regard to the deduction of seven points for the remarks section of the answer, petitioner notes that the model answer allots eight points for the remarks section and asks for one point additional to the one point he has already received credit therefor. Petitioner concedes the inadequacy of his

answer but argues that the statement of the inventor in the affidavit as to why the invention was not obvious to him does address the ground of rejection and therefore, merits one more point.

Petitioner's position is not well-taken. Aside from the fact that the affidavit makes up facts not presented in the Question and thus ignores the instruction that all information provided by the inventor is complete and accurate, a statement by the inventor that a claimed invention was not obvious to him is meaningless and irrelevant. The standard for obviousness is whether a claimed invention would have been obvious to one of ordinary skill in the art, not to the inventor himself. The award of one point for the remarks section was quite generous. It merits no additional points.

With regard to the deduction of eleven points for not preparing a petition to make special, petitioner argues that he should have been awarded at least four points for showing in his answer that he recognized the issues, and for making a major and substantial response.

While petitioner's answer recognized that a petition to make special on account of age was appropriate, he did not draft a petition per se. Rather, he stated in the remarks section of the amendment: "Because of the age of the applicant, we petition that this application be made special under 37 § 1.102. See attached affidavit for age verification." The affidavit, although not drawn to the issue

of special status on account of age, does list the inventor's date of birth.

The instructions clearly state that no credit will be given for any answer or notes merely explaining what course of action should be taken to respond to the Office action. Arguably, petitioner's answer is more than a mere explanation of the course of action to be taken. Two points will be added to petitioner's score.

CONCLUSION

Two points have been added to petitioner's regraded score of 64, for a total of 66. Since petitioner has not achieved a passing grade, the Director's decision of May 21, 1991 is affirmed. Therefore, this petition is denied.


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